

Application Serial No.: 09/931,257
Reply to Office Action dated August 26, 2003

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 2, 5-15, 18-28, and 30-41 are presently active in this case, Claims 1, 13, 15, 26, 34, and 36 having been amended and Claims 37-41 having been added by way of the present Amendment. Claims 3, 4, 16, 17, and 29 have been canceled from the present application without prejudice or disclaimer.

The Applicants wish to thank Supervisory Patent Examiner Paul Ip and Patent Examiner Jeffrey Zahn for the courtesies extended to Applicants' representatives, Christopher Ward and Kanichiro Yamamoto, during the personal interview conducted on December 3, 2003.

In the outstanding Official Action, Claims 1-36 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specific grounds for rejection are recited on pages 2-3 of the Official Action. The indefiniteness rejections were discussed extensively during the personal interview. In light of the discussion, the claims have been amended to clarify the language recited therein. For example, the claims have been amended to note that the temperature measuring element measures a temperature of the semiconductor laser element. Additionally, the claims have been amended to note that the temperature regulating unit is thermally connected to both the semiconductor laser element and the temperature measuring element. As noted during the interview, the Applicants submit that, while the phrase "temperature measuring element" is broad, the scope of this phrase is definite to one of ordinary skill in the art. The Applicants note that the "[b]readth of

Application Serial No.: 09/931,257
Reply to Office Action dated August 26, 2003

a claim is not to be equated with indefiniteness." (MPEP 2173.04.) The Applicants submit that the phrase "temperature measuring element" need not be limited to any specific embodiment of such a temperature measuring element, such as a thermistor, as is described in the specification as a non-limiting embodiment of such an element. Furthermore, where appropriate, the control unit has been identified as being electrically connected to the temperature measuring element, the temperature regulating unit, and the current detecting unit. Furthermore, the Applicants submit that the phrase regarding the semiconductor laser element including a diffraction grating to oscillate plural longitudinal modes is definite to one of ordinary skill in the art. The term "configured," which was originally used with regard to this limitation, has been removed in order to clarify the recited language.

Regarding the specific rejections of Claims 13, 14, and 17-25, the Applicants respectfully submit that the means-plus-function limitations mentioned on pages 3 of the Official Action are clearly definite under 35 U.S.C. 112, second paragraph. 35 U.S.C. 112, sixth paragraph explicitly states that "an element ... may be expressed as a means ... for performing a specified function without recital of structure, material, or acts in support thereof...." The Applicants note that the specification describes various non-limiting embodiments of the means-plus-function elements recited in the claims. By way of illustration and not limitation, the Applicants note that the specification describes a current detector (11) that detects a driving current, a temperature controller (12, 22) that controls a temperature regulating unit, and a storage unit (13, 23) that stores a control function. By way of illustration and not limitation, the Applicants also note that the specification describes a wavelength setting unit (24). The Applicants respectfully submit that the means-plus-function limitations satisfy the requirements of 35 U.S.C. 112, second paragraph.

Application Serial No.: 09/931,257
Reply to Office Action dated August 26, 2003

Accordingly, the Applicants request the withdrawal of the indefiniteness rejections.

Claims 1-36 were rejected under 35 U.S.C. 102(e) as being anticipated by Sato (U.S. Patent No. 6,393,041 B1). For the reasons discussed below, the Applicants traverse the anticipatory rejection.

Independent Claims 1, 13, 26, 34, and 36 of the present application have been amended to recite that the semiconductor laser element includes a diffraction grating to oscillate plural longitudinal modes. (See paragraphs 24 and 52 in the written description and Figure 10A.) As noted in the previous response and during the interview, the Applicants respectfully submit that the Sato reference does not disclose or even suggest such features. The Official Action indicated that these feature were not given patentable weight due to 35 U.S.C. 112, second paragraph, issue, however, as discussed above, the Applicants submit that the indefiniteness rejections have been overcome. (Additionally, the Applicants respectfully note that the fact that a limitation is considered indefinite does not mean that the limitation can be disregarded when considering prior art. See MPEP 2143.03, Indefinite Limitations Must Be Considered.)

Since the Sato reference fails to disclose a semiconductor laser element that includes a diffraction grating to oscillate plural longitudinal modes, as recited in Claims 1, 13, 26, 34, and 36 of the present application, then the Applicants respectfully submit that the Sato reference does not anticipate Claims 1, 13, 25, 34, and 36.

Claims 2, 5-12, 14, 15, 18-25, 27, 28, 30-33, and 35 are considered allowable for the reasons advanced for Claims 1, 13, 26, and 34 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claims 1, 13, 26, and 34.

Application Serial No.: 09/931,257
Reply to Office Action dated August 26, 2003

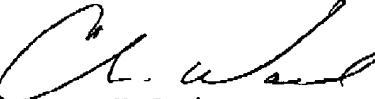
Accordingly, the Applicants respectfully request the withdrawal of the anticipation rejection.

Newly added Claims 37-41 are considered allowable as they recite features of the invention that are neither disclosed nor suggested by the references of record. For example, Claim 37 advantageously recites a mounting structure having a first portion thermally connected to the semiconductor laser element, and a second portion thermally connected to the temperature measuring element, whereby the temperature measuring element indirectly measures a temperature of the semiconductor laser element via heat transfer through the mounting structure. These features in combination with the control unit which utilizes the measured temperature, provide an invention that is not disclosed or suggested by the cited reference. Similar arguments are present for Claims 38-41.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Registration No. 40,073
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSM/MN 10/01)

BDL:CDW:brf
I:\atty\cdw\210424US8\am2.doc